

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE **RECEIVED**

Applicant : Ivan Markovic, et al.

Art Unit : 2178

JUN 16 2003

Serial No. : 08/978,753

Examiner : Cesar B. Paula

Filed : November 26, 1997

Technology Center 2100

Title : DISPLAYING THE APPEARANCE OF A PRINTED AND ASSEMBLED
DOCUMENTSC
#29

6/18/03

Mail Stop Appeal Brief - Patents

Commissioner for Patents

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REPLY BRIEF ON APPEAL**OFFICE OF PETITIONS**

Pursuant to 37 CFR 1.193(b)(1), Applicant responds to the new points raised in the Examiner's Answer mailed April 8, 2003 as follows.

I. (Examiner's Answer Page 22, Paragraph 1)

The Examiner states that "the Appellants submit that the Tabata [reference] fails to teach: "determine and then display the visual appearance of the electronic document as is printed and assembled according with an instruction" (p.4, L.15-25). It is noted that the features upon which appellants rely (i.e., 'the visual appearance of the electronic document as is printed and assembled according with an instruction') are not recited in the rejected claim(s)" (emphasis in the original). Applicant respectfully disagrees.

Claim 1 recites determining in the computer indicia of assembly and a visual appearance of the first electronic document as if printed and assembled in accordance with an instruction; and displaying the determined visual appearance with the indicia of assembly overlaid with content (emphasis added). The antecedent basis for the term "*the determined visual appearance*" in claim 1 is "*determining ... a visual appearance of the first electronic document as if printed*

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and assembled in accordance with the instruction”. Thus, the step of displaying the determined visual appearance includes displaying the visual appearance of the electronic document as if printed and assembled in accordance with an instruction. Therefore, the features upon which the Applicant relies are recited in the rejected claims.

II. (Examiner's Answer Page 24, Paragraph 2)

The Examiner states that “[i]n response to appellants' arguments against the references individually (p.6,L.9-p.7,L.3), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.”

However, to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20USPQ2d 1438 (Fed. Cir. 1991). As noted in Applicant's arguments presented on page 6, line 9 – page 7, line 3 of Applicant's Brief on Appeal, none of the references teach or suggest displaying the determined visual appearance with the indicia of assembly overlaid with the content. Consequently, the combination of the references cannot teach displaying the determined visual appearance with the indicia of assembly overlaid with the content.

III. (Examiner's Answer Page 27, Paragraph 2)

The Examiner states that “in response to appellants' argument that the references fail to show certain features of appellants' invention, it is noted that the features upon which the appellants rely (i.e., 'Tabata fails to disclose that the instruction identifies a printing media to be used in the hardcopy document' p.12,L.7-8, 12-14 are not recited in the rejected claim(s). The claim recites 'selecting pre-printing physical characteristics of a print media material' L.4, and not the identification of the type of media to be used” (emphasis in original).

Applicant notes that the specific phrase that the “instruction identifies a printing media to be used in the hard copy document” is not used in the claim. However, Applicant's arguments remain valid for the reasons discussed below.

As discussed in the Appeal Brief at page 11, line 27 – page 13, line 15, neither Tabata, Miller, nor Takakura, either alone or in combination, discloses an instruction that identifies a

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printing media to be used in the hard copy document. Since these three references do not teach an instruction that identifies a print media, they cannot teach an instruction that selects the pre-printing physical characteristics of a print media on which the electronic document will be printed.

For these reasons, and the reasons stated in the Appeal Brief, Applicant submits that the final rejection should be reversed.

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Respectfully submitted,



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